



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,383	04/09/2004	Christopher H. Porter	203/505 MB-104	1604

27224 7590 03/06/2009
ARTHUR FREILICH
FREILICH, HORNBAKER & ROSEN
20555 DEVONSHIRE ST. #372
CHATSWORTH, CA 91311

EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT	PAPER NUMBER
----------	--------------

3763

MAIL DATE	DELIVERY MODE
-----------	---------------

03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,383	Applicant(s) PORTER ET AL.	
	Examiner CHRISTOPHER D. KOHARSKI	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8, 10-12 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8, 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

The Examiner acknowledges the reply filed 12/01/2008 in which claims 3-4 and 18-21 were amended and new claims 22-23 were added. Currently claims 3-8, 10-12 and 18-23 are pending for examination in this application with claims 10-12 withdrawn from a previous election restriction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

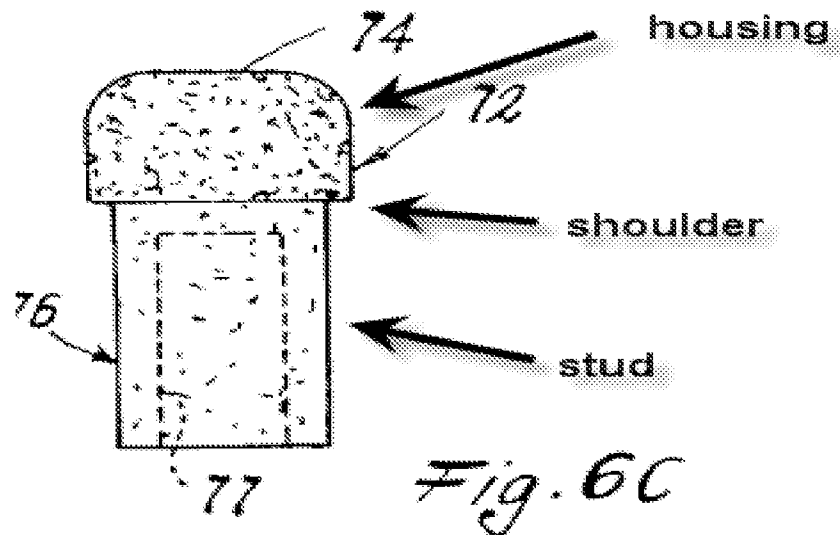
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-8 and 18-23 are rejected under 35 U.S.C 103(a) as being unpatentable over Beoni (USPN5,814,104) in view of de Groot (EP0367354). Beoni discloses a middle ear ossicular chain prosthesis.

Regarding claims 3-8 and 18-23, Beoni discloses a medical device comprising (Figures 6C): a housing body (74) having a longitudinal peripheral surface (near 72)

Art Unit: 3763

defining a substantially uniform lateral dimension capable of subcutaneous implantation by surgical tunneling; a stud (76) projecting longitudinally from said housing body (74) capable of percutaneous implantation having an inner end adjacent to said housing (72) body and an outer end spaced longitudinally therefrom to define a longitudinal peripheral surface; a shoulder surface (intersection of 72 and 76) on said housing body (72) extending laterally from said housing body longitudinal peripheral surface to said stud longitudinal peripheral surface; a longitudinally extending porous layer (entire surface of device shown in Figure 6C) carried by said stud longitudinal peripheral surface having a lateral dimension no greater than said housing body lateral dimension; a laterally extending porous layer carried by said shoulder surface having a lateral dimension no greater than said housing body lateral dimension; and wherein said longitudinally extending and said laterally extending porous layers orthogonally (intersection of 72, 76) abut one another and wherein each of said porous layers is characterized by a pore size within the range of 50 to 200 microns (col 3, ln 35-40) (Figures 5A-6C).



Beoni meets the claim limitations as described above except for the specific porosity and metallic materials.

However, de Groot teaches a percutaneous implant.

Regarding claims 3-08 and 18-23, de Groot teaches with a percutaneous implant (10) with a porous surface (3) which contains a sintered fibrous metal mesh such as stainless steel a porosity of between 60% to 95% (Figures 1-2, col 2, ln 10-45).

At the time of the invention, it would have been obvious to use the porous materials of de Groot with the system of Beoni to act and as equivalent tissue attachment system. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of de Groot (cols 1-2).

Response to Arguments

Applicant's arguments with respect to claims 3-8 and 18-23 have been considered but are moot in view of the new ground(s) of rejection.

Suggested Subject Matter

The following claim subject matter is suggested by the examiner and considered to distinguish patentably over the art of record in this application and is therefore presented to Applicant for consideration:

The Examiner suggests further clarification of the porous layer location and size relative to the housing and stud.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, see PTO-90.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3763

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 5:30am to 2:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 03/02/2009

/Christopher D Koharski/
Examiner, Art Unit 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763